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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,400	08/12/2002	Kunio Kawaguchi	450101-03365	4955
20999 7590 01/25/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER KOROBOV, VITALI A	
			ART UNIT 2155	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/089,400	Applicant(s) KAWAGUCHI ET AL.	
	Examiner Vitali Korobov	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This Office Action is in response to the amendment filed on 09/27/2007. Claims 6-13 are withdrawn from consideration. Of the remaining claims, claims 1-5 and 14-16 were previously amended. Accordingly, claims 1-5 and 14-19 are currently pending and have been examined in this Office Action.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

The specification fails to provide proper antecedent basis for the claimed subject matter "module", found in claims 1 and 5, and "medium", found in claims 17-19.

Appropriate correction is required.

Claim Objections

3. Claim 18 is objected to because of the following informalities: It is missing a period at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 1-5 and 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 5 are directed to an information picture utilization system, comprising various modules. The use of the term "system" does not inherently mean that the claim is directed to a "machine", and the use of the term "module" does not inherently mean that the claim is directed to a "device".

The dependent claims 2-4 suffer from the same deficiency as the claim 1 they depend from, and therefore are rejected under the same rationale as claim 1.

Claims 17-19 are each directed to "an information recording medium", which does not inherently mean computer readable medium. The specification does not describe "an information recording medium" in a way that rules out such non-statutory categories as paper print-outs or program instructions imbedded in a "carrier signal".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 and 17-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a

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way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 5 comprise limitations directed to various "modules". The specifications do not contain a description of a "module" or "modules" in a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As a matter of fact, the term "module" is not found anywhere in the specifications.

The dependent claims 2-4 suffer from the same deficiency as the claim 1 they depend from, and therefore are rejected under the same rationale as claim 1.

Claims 17-19 comprise limitations directed to "information recording medium". The specifications do not contain a description of an "information recording medium" in a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As a matter of fact, the term "information recording medium" is not found anywhere in the specifications.

6. Claim 1-5 are further rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 5 contain limitation directed to "when an operation command is given independent of a period of time". This subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The dependent claims 2-4 suffer from the same deficiency as the claim 1 they depend from, and therefore are rejected under the same rationale as claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1-5 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by the U. S. Patent No. 7,039,877, issued to Merriman et al., hereinafter Merriman.

Regarding claim 1, Merriman teaches an information picture utilization system comprising: a client module for sending notification regarding recording of an information picture (4:14-30 - feedback loop 23 (Fig.1) provides notification of recording of information picture (Fig. 2, step 36)); and a server module for receiving the notification regarding the recording of the information picture (4:66-

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67 and 5:1-6 - advertisement and predictive model servers), wherein the client module sends information for specifying the information picture by utilizing picture information and related information (4:31-43 - feedback information), wherein the information for specifying the information picture causes a predetermined operation to be processed as a single unit when an operation command is given independent of a period of time (4:44-49 - automatic update of ad delivery monitoring database).

Regarding claim 2, Merriman teaches the information picture utilization system as set forth in claim 1, wherein said information picture includes time limit information in said related information; and said client inhibits execution of the notification to the server by interpreting said time limit information (4:49-53 - execution is limited by time period).

Regarding claim 3, Merriman teaches the information picture utilization system as set forth in claim 1, wherein said information picture includes time limit information in said related information; and said client inhibits execution of a predetermined operation by interpreting said time limit information (4:49-53).

Regarding claim 4, Merriman teaches the information picture utilization system as set forth in claim 1, wherein said client inhibits execution of the notification to the server on the basis of operation history based on the information picture (4:49-53).

Regarding claim 5, Merriman teaches an information picture utilization system comprising: a client module for sending a notification regarding recording of an information picture (4:14-30 - feedback loop 23 (Fig.1) provides notification

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of recording of information picture (Fig. 2, step 36)); and a server module for receiving the notification regarding the recording of the information picture (4:66-67 and 5:1-6 - advertisement and predictive model servers), wherein the information picture is sent and recorded into said server module by utilizing picture information and related information (4:31-43 - feedback information), and wherein the utilization of the picture information and the related information causes a predetermined operation to be processed as a single unit when an operation command is given independent of a period of time (4:44-49 - automatic update of ad delivery monitoring database).

Regarding claim 14, Merriman teaches an information picture management apparatus for carrying out management of an information picture in which picture information and related information for prescribing at least peculiar processing are caused to be one handling unit, which is delivered to an information terminal connected through network, wherein said information picture management apparatus comprises: a registration information recording unit for recording registration information relating to information picture delivered to the information terminal and registered (4:31-43 and Fig. 1, database 20 is recording registration information relating to information picture - banner ads served); an updating permission/negation unit for determining permission/negation of updating with respect to information picture caused to undergo management by the registration information in accordance with updating condition set in advance (4:44-53 - pre-sets on direct advertising campaigns that are set in advance); and an information picture updating unit for updating processing with respect to

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information picture determined to be permitted by the updating permission/negation section (4:49-53 - banner serving criteria).

Regarding claim 15, Merriman teaches the information picture management apparatus as set forth in claim 14, wherein information pictures within the range from the number where at least one of registration and updating of the information picture is approximately a time up to a predetermined number should be updated as the updating condition (5:14-27).

Regarding claim 16, Merriman teaches the information picture management apparatus as set forth in claim 15, wherein predetermined numbers are set with respect to respective ones of plural information terminals, and are changed in accordance with change instructions from the information terminals (5:14-27).

Claims 17-19 are rejected in view of the above rejection of claims 14-16. Claims 17-19 are essentially the same as claims 14-16, respectively, except that they set forth the invention as a computer program product rather than an apparatus, as do claims 14-16.

Response to Arguments

8. Applicant's arguments with respect to the pending claims 1-5 and 14-19 have been considered but are moot in view of the new ground(s) of rejection, necessitated by the Applicant's amendment.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01/18/2008
VAK

Vitali Korobov
Examiner
Art Unit 2155


PHILIP TRAN
PRIMARY EXAMINER